

REMARKS

In the Office Action¹, the Examiner rejected claims 1-68 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2002/0077082 to *Cruickshank et al.* ("*Cruickshank*") in view of U.S. Patent Application Publication No. 2002/0076027 to *Bernnan et al.* ("*Bernnan*").

By this Amendment, Applicants amend claims 64 and 66, and add new claims 69 and 70.

I. The Telephonic Interview of April 14, 2010

Applicants thank the Examiner for the time and courtesy extended during the telephonic interview of April 14, as well as several follow-up calls with Applicants' representative. During the discussions, the Examiner suggested adding the recitations of dependent claim 9, as well as recitations directed to "application software" and "multiparty communication," to independent claim 1 would place claim 1 in condition for allowance.

As set forth below, Applicants maintain that independent claim 1 is allowable over the art of record. Nevertheless, Applicants have added new independent claim 69, which includes recitations similar to independent claim 1, as well as recitations directed to "application software" and "multiparty communication." Moreover, Applicants have added new dependent claim 70, which includes recitations similar to dependent claim 9.

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome this rejection, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to the rejection (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

Accordingly, Applicants respectfully request that, in the event the claims of this application are not allowed in the next action, the Examiner indicate allowable subject matter in at least new dependent claim 70, as the Examiner has stated that such recitations constitute allowable subject matter.

II. The Office Action Improperly Fails to Comply with M.P.E.P. § 706.02(j)

M.P.E.P. § 706.02(j) states that the examiner should set forth “the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s)” (emphasis added). Moreover, 37 C.F.R. § 1.104(c)(2) states, “when a reference is complex or shows or describes other inventions other than that claimed by applicant, the particular part relied on must be designated as nearly as practicable” (emphasis added).

Here, the Office Action fails to comply with M.P.E.P. § 706.02(j). For example, the Office Action rejects numerous dependent claims by citing to one or more paragraphs of unidentified references (Office Action at pages 4-5). As an example, in addressing claim 2, the Office Action relies on paragraph 32 of an unspecified reference (Office Action at page 4). It is not apparent from the Office Action whether the *Cruickshank* or *Bernnan* reference is applied to dependent claim 2 (Office Action at page 4). The Office Action includes numerous other citations to paragraphs of unspecified references.

Accordingly, the Office Action fails to comply with M.P.E.P. § 706.02(j). Applicants respectfully request that, in the event that the next Office communication is not a Notice of Allowance, the Office mail a new non-final Office Action clarifying the rejection under 35 U.S.C. § 103(a).

III. The Office Action Improperly Fails to Comply with MPEP § 707.07(f)

MPEP § 707.07(f) states, “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant’s argument and answer the substance of it” (emphasis added). In the Amendment filed August 6, 2009, Applicants traversed the rejections in the Final Office Action mailed May 13, 2009, pointing out numerous deficiencies in the applied references (See Amendment at pages 27-30).

Here, the Office Action mailed December 24, 2009 continues to rely exclusively on the *Cruickshank* and *Bernnan* references in rejecting the claims of this application under 35 U.S.C. § 103(a). However, the Office Action does not include any rebuttal of Applicants’ position as set forth in the Amendment. For this reason, the Office Action fails to comply with MPEP § 707.07(f). Thus, Applicants respectfully request that, in the event that the next Office communication is not a Notice of Allowance, the Office mail a new non-final Office Action clarifying which references are applied to each of the dependent claims.

III. The Rejection of Claims 1-68 Under 35 U.S.C. § 103(a)

Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1-68 under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims.

A. Claims 1-13, 24-36, 47, and 49-61

Claim 1, for example, recites a method comprising, *inter alia*, “connecting the call between the calling party and the called party when the calling party denies the collaboration request” (emphasis added).

Cruickshank discloses handheld computing devices that connect to a voice messaging server via a wireless connection or via PSTN (*Cruickshank*, ¶ 15). The handheld computing devices can download voice messages from the voice messaging server, and display text messages associated with the voice messages (*Cruickshank*, ¶ 16). The text messages can include information such as the calling line ID of the caller that left the message, the time of day the voice message was received, or business card information such as a vCard (*Cruickshank*, ¶¶ 19-20). *Cruickshank* also discloses that a user may, while reviewing a particular voice message, initiate an instant messaging session with the caller who left the voice message (*Cruickshank*, ¶ 28). To review the voice message, the user may use a handheld cellular telephone to download voice messages from a messaging server (*Cruickshank*, ¶ 31).

The Office Action relies on *Cruickshank*'s user downloading the voice message in addressing the claimed "connecting the call between the calling party and the called party when the calling party denies the collaboration request" (Office Action at page 3). However, when *Cruickshank*'s user downloads the voice message from the message server, the user is not connected to the user who left the voicemail, or to an instant messaging user (*Cruickshank*, ¶ 31). Accordingly, *Cruickshank* does not, contrary to the allegations in the Office Action, teach or suggest "connecting the call between the calling party and the called party when the calling party denies the collaboration request," as recited by independent claim 1 (emphasis added)

Bernnan discloses a method for establishing a message composing session for a calling party when the calling party cannot have a synchronous call to a called party (*Bernnan*, abstract). The message composing session uses information retrieved from

a database to fill in certain parameters in a message, such as the called party's voice mail address, e-mail address, etc. (*Bernnan*, ¶ 42). Once the message is composed, the calling party sends the message to the called party (*Bernnan*, ¶ 47).

Bernnan also discloses handling a synchronous call attempt from a calling party to a called party by detecting that the calling party wishes to send a message to the called party (*Brennan*, ¶ 10). However, *Bernnan*'s calling party is not denying a collaboration request by attempting to send the called party a message. Accordingly, *Bernnan* fails to disclose or suggest connecting a call when a calling party denies a collaboration "connecting the call between the calling party and the called party when the calling party denies the collaboration request," as recited by independent claim 1 (emphasis added).

Since *Cruickshank* does not disclose or suggest "connecting the call between the calling party and the called party when the calling party denies the collaboration request" and *Bernnan* does not disclose or suggest "connecting the call between the calling party and the called party when the calling party denies the collaboration request," the combination of these references also does not disclose or suggest this "connecting" step. Thus, a *prima facie* case of obviousness has not been established with respect to claim 1 on the basis of a combination of these references.

Independent claims 24, 47, and 49, though of different scope from claim 1, recite features similar to those set forth above with respect to claim 1. Claims 24, 47, and 49 are therefore allowable for reasons similar to those presented above with regard to claim 1.

Claims 2-13, 25-36, and 50-61 depend from one of the independent claims, and the dependent claims are therefore allowable at least due to their dependence from allowable base claims.

B. Claims 14-23, 37-46, 48, and 62-68

Independent claim 14, for example, recites a method comprising, *inter alia*, “receiving, while the call is available to be answered by the called party, a response to the notification of the call from the called party indicating that the called party requests a collaboration to share data interactively with the calling party” (emphasis added).

As discussed, *Cruickshank* discloses that a user may, while reviewing a particular voice message, initiate an instant messaging session with the caller who left the voice message (*Cruickshank*, ¶ 28). *Cruickshank* also discloses that, if the user of a handheld device receives a new voice message while the handheld device is in communication with an instant messaging server, the voice messaging server may use the instant messaging server to indicate to the user that they have a new voicemail (*Cruickshank*, ¶ 29).

The Office Action relies on *Cruickshank*’s disclosure of using the instant messaging server to inform the user of new voicemails as allegedly constituting “receiving while the call is available to be answered by the called party, a response to the notification from the called party indicating that the called party requests a collaboration to share data interactively with the calling party” (Office Action at page 6). However, *Cruickshank* discloses that the voice messages are reviewed by the user offline, and accordingly, any incoming call associated with the voice message is no longer available to be answered (See *Cruickshank*, ¶ 36). Accordingly, *Cruickshank*

does not teach or suggest “receiving, while the call is available to be answered by the called party, a response to the notification of the call from the called party indicating that the called party requests a collaboration to share data interactively with the calling party,” as recited by independent claim 14 (emphasis added)

Bernnan fails to cure the above-noted deficiencies of *Cruickshank*. As discussed, *Bernnan* discloses handling a synchronous call attempt from a calling party to a called party by detecting that the calling party wishes to send a message to the called party (*Bernnan*, ¶ 10). *Bernnan* also discloses that the call is not necessarily dropped even though the calling party wishes to send a message (*Bernnan*, ¶ 10). However, *Bernnan* does not disclose or suggest that the called party can request a collaboration while the call is available to be answered. Accordingly, *Bernnan* does not teach or suggest “receiving, while the call is available to be answered by the called party, a response to the notification of the call from the called party indicating that the called party requests a collaboration to share data interactively with the calling party,” as recited by independent claim 14 (emphasis added).

Since *Cruickshank* does not disclose or suggest “receiving, while the call is available to be answered by the called party, a response to the notification of the call from the called party indicating that the called party requests a collaboration to share data interactively with the calling party” and *Bernnan* does not disclose or suggest “receiving, while the call is available to be answered by the called party, a response to the notification of the call from the called party indicating that the called party requests a collaboration to share data interactively with the calling party,” the combination of these references also does not disclose or suggest this “receiving” step. Thus, a *prima facie*

case of obviousness has not been established with respect to claim 14 on the basis of a combination of these references.

Independent claims 37, 48, and 62-68, though of different scope from claim 14, recite features similar to those set forth above with respect to claim 14. Claims 37, 48, and 62-68 are therefore allowable for reasons similar to those presented above with regard to claim 14.


Claims 15-23 and 38-46 depend from one of the independent claims, and the dependent claims are therefore allowable at least due to their dependence from allowable base claims.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,


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